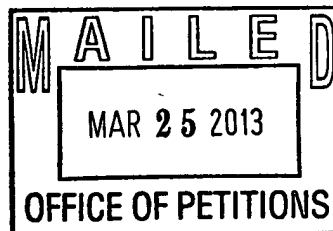




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In re Patent No. 6,473,617 :
Issue Date: October 29, 2002 :
Application No. 09/381,040 : DECISION ON PETITION
Filed: October 12, 1999 :
Attorney Docket No. CU-1991TJK :

This is a decision on the Petition For Expungement of Assignment Records Pursuant to MPEP 323.01(d), filed February 6, 2013, which is being treated as a petition under 37 CFR 1.182 to expunge an assignment document previously recorded against the above-identified patent application.

The petition fee for petitions under 37 CFR 1.182 is currently \$400 and this fee has been charged to petitioner's deposit account as authorized.

The petition is **dismissed**. This is not a final agency action.

Petitioner requests that the assignment recorded at reel/frame 028434/0243 be expunged as the document is not an assignment of patent rights.

As discussed in section 323.01(d) of the Manual of Patent Examining Procedure (MPEP), petitions to correct, modify or "expunge" assignment records are rarely and granted only if the petitioner can prove that:

- (A) the normal corrective procedures outlined in MPEP § 323.01(a) through §323.01(c) will not provide the petitioner with adequate relief; and
- (B) the integrity of the assignment records will not be affected by granting the petition.

Petitioner has not proven either item A or B.

In regard to item A, the corrective procedures outlined in MPEP § 323.01 (a) through § 323.01(c) are not limited to only typographical errors or errors that are minor in nature. A corrective document may be recorded as set forth below, contrary to the assertions set forth in the petition.

Furthermore, in regard to item B, the removal of a document in its entirety, as requested, will affect the assignment records. The petition contends that expungement would not affect the integrity of the assignment records as the document is not an assignment of patent rights. However, the integrity of the records is recognized as separate from the chain of title. Thus, the integrity of the assignment records is not preserved by merely presenting a desired and unproven chain of title. Also, expungement would prevent the records from being searchable in the Assignment Historical Database or otherwise available to the public, which may be necessary for a competent authority to determine the proper chain of title. Petitioner indicates it is proper to expunge the assignment document as it is not an assignment of patent rights.

Here, petitioner seeks an extraordinary remedy, properly addressed under 37 CFR 1.182. The USPTO will not normally resort to an extraordinary remedy under 37 CFR 1.182 if the rules of practice and the procedures before the USPTO already provide an avenue for the requested relief. See Cantello v. Rasmussen, 220 USPQ 664, (Comm'r Pats. 1982).

As background, the USPTO simply acts in a ministerial capacity in recording documents that have been submitted for recordation. See 35 USC 261 and 37 CFR 3.11. However, the recording of a document pursuant to 37 CFR 3.11 is **not** a determination by the USPTO of the validity of the document *per se* or the effect that document has on the title to a patent or application. See 37 CFR 3.54. Moreover, it is USPTO policy to maintain a complete history of claimed interests in a given property, and, as such, a recorded assignment document will be retained, even if it is subsequently found to be invalid. In re Raney, 24 USPQ2d 1713 (Comm'r Pat. 1992).

As set forth in MPEP 323, an error in a recorded assignment is not corrected by invalidating the previous document, but by simply submitting a "corrective document" that explains the nature of the recorded document so as to clarify the assignment records. "Corrective documents" are not limited to assignments, but include any documents affecting title to a patent or application. See MPEP § 313. This would include an explanation of the recorded document so as to clarify the assignment records. The new recordation form cover sheet must identify the submission as a "corrective document" submission and indicate the reel and frame number where the incorrectly recorded assignment document appears. The person signing the new recordation form cover sheet must state that the information provided on the new cover sheet is true and correct and that any copy submitted is a true copy of the original document. The original cover sheet should be submitted with the corrective document. The corrective document will be recorded and given a new reel and frame number and recording date. The recording fee set forth in 37 CFR 1.21(h) is required for each patent application and patent against which the corrective document is being recorded. See MPEP § 302.06.

Petitioner appears to be requesting what amounts to "house cleaning" of the assignment records. The rules of practice and the procedures before the USPTO provide an avenue for the requested relief without relying upon extraordinary measures. As a request for the Office to invalidate an assignment is both extraordinary and contrary to USPTO policy, this petition must be dismissed.

Although the petition was submitted with the reel and frame number for the assignment document, petitions are decided within application and patent files. Furthermore, submission of a document to the assignment database will result in that document being recorded therein with no further action other than the recordation. Further, documents submitted to the assignment database must include a coversheet to ensure that they are properly routed. Accordingly, the petition filed February 6, 2013 has been considered with regard to Patent No. 6,473,617, application serial number 09/381,040, only and is not present in the files of the other cited patents or applications. Also, the required petition fee under 37 CFR 1.17(f), filed with the petition, has been applied to the file for Patent No. 6,473,617 only. If petitioner desires consideration of the petition in any of the other cited patent and/or application files, a separate petition under 37 CFR 1.182 (and fee) must be filed in each of the files to be considered in accordance with 37 CFR 1.4(b).

Telephone inquiries concerning this communication in regard to the petition to expunge assignment documents should be directed to Carl Friedman at (571)272-6842.



Christopher Bottorff
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